

TRAITE DE COOPERATION EN MATIERE DE BREVETS

PCT

NOTIFICATION D'ELECTION

(règle 61.2 du PCT)

Expéditeur: le BUREAU INTERNATIONAL

Destinataire:

Commissioner
US Department of Commerce
United States Patent and Trademark
Office, PCT
2011 South Clark Place Room
CP2/5C24
Arlington, VA 22202
ETATS-UNIS D'AMERIQUE
en sa qualité d'office élu

Date d'expédition (jour/mois/année) 13 août 2001 (13.08.01)	
Demande internationale no PCT/FR00/02805	Référence du dossier du déposant ou du mandataire RS 282-AB/CJ
Date du dépôt international (jour/mois/année) 10 octobre 2000 (10.10.00)	Date de priorité (jour/mois/année) 11 octobre 1999 (11.10.99)
Déposant CHABRIER de LASSAUNIERE, Pierre-Etienne etc	

1. L'office désigné est avisé de son élection qui a été faite:



dans la demande d'examen préliminaire international présentée à l'administration chargée de l'examen préliminaire international le:

02 mai 2001 (02.05.01)



dans une déclaration visant une élection ultérieure déposée auprès du Bureau international le:

2. L'élection ☒ a été faite

n'a pas été faite

avant l'expiration d'un délai de 19 mois à compter de la date de priorité ou, lorsque la règle 32 s'applique, dans le délai visé à la règle 32.2b).

Bureau international de l'OMPI 34, chemin des Colombettes 1211 Genève 20, Suisse no de télécopieur: (41-22) 740.14.35	Fonctionnaire autorisé P. Blanchet (Fax 338.87.40) no de téléphone: (41-22) 338.83.38
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Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

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Applicant's or agent's file reference RS 282-AB/CJ	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/FR00/02805	International filing date (day/month/year) 10 October 2000 (10.10.00)	Priority date (day/month/year) 11 October 1999 (11.10.99)
International Patent Classification (IPC) or national classification and IPC A61K 31/426		
Applicant SOCIETE DE CONSEILS DE RECHERCHES ET D'APPLICATIONS SCIENTIFIQUES (S.C.R.A.S.)		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.	
2. This REPORT consists of a total of <u>7</u> sheets, including this cover sheet.	
<input checked="" type="checkbox"/>	This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
These annexes consist of a total of <u>8</u> sheets.	
3. This report contains indications relating to the following items:	
I <input checked="" type="checkbox"/>	Basis of the report
II <input type="checkbox"/>	Priority
III <input checked="" type="checkbox"/>	Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
IV <input type="checkbox"/>	Lack of unity of invention
V <input checked="" type="checkbox"/>	Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
VI <input type="checkbox"/>	Certain documents cited
VII <input type="checkbox"/>	Certain defects in the international application
VIII <input checked="" type="checkbox"/>	Certain observations on the international application

Date of submission of the demand 02 May 2001 (02.05.01)	Date of completion of this report 25 January 2002 (25.01.2002)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/FR00/02805

I. Basis of the report

1. This report has been drawn on the basis of (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

- ☒ the international application as originally filed.
- ☐ the description, pages 1-178, as originally filed,
 pages _____, filed with the demand,
 pages _____, filed with the letter of _____,
 pages _____, filed with the letter of _____.
- ☐ the claims, Nos. 1-18,19(partie), as originally filed,
 Nos. _____, as amended under Article 19,
 Nos. _____, filed with the demand,
 Nos. 19(partie),20,21, filed with the letter of 14 December 2001 (14.12.2001),
 Nos. _____, filed with the letter of _____.
- ☐ the drawings, sheets/fig _____, as originally filed,
 sheets/fig _____, filed with the demand,
 sheets/fig _____, filed with the letter of _____,
 sheets/fig _____, filed with the letter of _____.

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

4. Additional observations, if necessary:

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Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: III.

The elements in respect of which no international search report has been established will not be the subject of an international preliminary examination (PCT Rule 66.1(e)).

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V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

Novelty (N)	Claims	7, 8, 13, 15, 18, 20	YES
	Claims		NO
Inventive step (IS)	Claims	7, 8, 13, 15, 18, 20	YES
	Claims		NO
Industrial applicability (IA)	Claims	see separate sheet	YES
	Claims		NO

2. Citations and explanations

The applicant's attention is drawn to the fact that the present opinion relating to novelty, inventive step and industrial applicability only applies to those elements in respect of which a search report has been established, in other words, the compounds of Claims 7, 8, 13, 15, 18 and 20 and the use thereof for one of the disease states mentioned on page 72, lines 19-24.

1. Claims 7, 8, 13, 15, 18 relate to a composition or substance used in methods of medical treatment.

There is no single PCT criterion for assessing the industrial applicability of Claims 7, 8, 13, 15, 18. Patentability may also depend on the wording of the claims. The European Patent Office, for example, does not recognise the industrial applicability of the subject matter of claims to the medical use of a compound; it does, however, allow claims to the first medical use of a known compound or to the use of such a compound in the manufacture of a drug for a new medical treatment.

2. Although the present opinion has been drawn only for those elements in respect of which no international search report has been established, it is important to note that

the subject matter of Claims 1-6, 9-12, 14, 16, 17, 19, 21 is not novel over the prior art cited in the international search report. Indeed, a newly discovered technical effect (in the present case new pharmacological properties) does not confer novelty on a claim relating to the use of a known substance for a known medical treatment.

Moreover, the applicant is reminded that all the embodiments covered by the claims should meet the criterion of inventive step. If inventive step relies solely on obtaining a technical effect, such as the inhibition of monoamine oxidases, of lipid peroxidation or, in the present case, sodium channel modulation, substantially all the embodiments must result in said effect.

However, in view of the number of compounds claimed, it is highly unlikely that all or almost all of said compounds have the alleged effect, and therefore that substantially all the solutions claimed solve the problem.

Hence, since the subject matter of Claims 1-6, 9-12, 14, 16, 17, 19 and 21 in its entirety does not convincingly appear to have said technical effect, it cannot involve an inventive step.

3. The subject matter of Claims 7, 8, 13, 15, 18 and 20 appears to be novel and inventive in view of the prior art cited in the international search report (PCT Article 33(2) and (3)).

3.1 No document discloses the products of Claim 20, those of Claim 18, used as medicaments, or the use of the compounds as defined in Claims 7, 8, 13 and 15 to inhibit monoamine oxidases and lipid peroxidation or to modulate

sodium channels to treat the disease states mentioned on page 72, lines 19-24.

3.2 In view of the prior art, the problem to be solved by the present application is that of providing compounds having one of the following three effects: inhibiting monoamine oxidases, inhibiting lipid peroxidation or modulating sodium channels.

The prior art does not provide any indication that might lead a person skilled in the art to select the compounds of Claims 7, 8, 13, 15, 18 and 20 to solve the problem addressed.

VIII. Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

1. The present Claims 1-6, 9-12, 14, 16, 17, 19 and 21 relate to a wide variety of compounds. In fact, said claims contain so many options, variables, possible permutations and conditions that a significant lack of clarity and conciseness arises under the terms of PCT Article 6. Said claims are so vague that determining the subject matter thereof would require undue effort from the reader.

2. The present Claims 1-5 relate to the use of a product of general formula (I) to treat diseases that are not clearly defined. Definitions such as "inhibiting monoamine oxidases", "inhibiting lipid peroxidation" and "having a modulatory effect relative to sodium channels" are vague and ambiguous and cast a doubt as to the meaning of the technical features (i.e. the diseases) to which they refer.

Inhibiting monoamine oxidases and lipid peroxidation or modulating sodium channels cannot be considered on their own to be a therapeutic application. Once the mechanism of action of a substance has been discovered, it should lead to a practical application in the form of an actual defined treatment for a disease state.